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PATENT APPLICATION

ATTORNEY DOCKET NO. 10013718-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert E. Haines

Confirmation No.: 7082

Application No.: 09/981,885

Examiner: Tamra Dicus

Filing Date: Oct. 17, 2001

Group Art Unit 1774

Title: Media Imprinted With Media Parameter Information

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Jan. 17, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Respectfully submitted,

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By [Signature]

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Robert Haines

ATT. DOCKET NO.: 10013718-1

SERIAL NO.: 09/981,885

GROUP ART UNIT: 1774

FILED: October 17, 2001

EXAMINER: Tamra Dicus

TITLE: Media Imprinted With Media Parameter Information

APPELLANT'S/APPLICANT'S OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1, 3-5, 32-34, 38-39 and 41-43 are pending. Claims 2, 6-31, 35-37 and 40 have been canceled. The rejection of all pending claims is appealed. Only the pending claims are listed in Appendix I.

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4. STATUS OF AMENDMENTS.

No amendments to the claims were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

The claims relate to printer sheet media marked on an edge and on a face with information that may be used to configure a printer or other imaging device.

Claim 1, for example, is directed to a sheet of print media that includes: a face (e.g., face 106 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); an edge adjoining the face (e.g., edge 104 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); and a fluid-based marking on the face of the sheet and on the edge of the sheet, the marking continuous from the face of the sheet to the edge of the sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheet (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6 and page 10, lines 4-10).

Claim 5, for example, is directed to a stack of print media sheets having a fluid based marking imprinted on an edge side thereof (e.g., stack 302 and sheets 100 in Fig. 3 and Specification page 6, lines 7-15), the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack (e.g., Specification, page 5, line 15-24 and page 10, lines 4-10).

Claim 32, for example, is directed to a sheet of print media that includes: a plurality of faces (e.g., face 106 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); an edge adjoining each face (e.g., edge 104 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); and a fluid-based marking imprinted on a face of the sheet and on an edge adjoining the face,¹ the fluid-based marking continuous from the face of the sheet to the edge of the sheet and the marking representing machine readable media parameters corresponding to the sheet (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6 and page 10, lines 4-10).

¹ Claim 32 includes an obvious scrivener's error that was not discovered until preparation of the appeal brief. Claim 32 recites "imprinted on a face of the sheet and on an edge *of* adjoining the face...." (emphasis added) The phrase "an edge of adjoining the face" doesn't make sense -- "of" should have been omitted. The correct wording is also evident from the prior recitation in Claim 32 of "an edge adjoining each face...."

Claim 38, for example, is directed to a stack of print media sheets having a fluid based marking imprinted on an edge side thereof (e.g., stack 302 and sheets 100 in Fig. 3 and Specification page 6, lines 7-15), the marking representing machine readable media parameters corresponding to the sheets in the stack (e.g., Specification, page 5, line 15-24 and page 10, lines 4-10).

Claim 39, for example, is directed to a stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed (e.g., stack 402 and sheets 100 in Fig. 4 and Specification page 7, lines 9-18), and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet, the marking continuous from the face of each sheet to the edge of each sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6 and page 10, lines 4-10).

6. GROUNDS OF REJECTION TO BE REVIEWED.

1. The recitation of a marking representing machine readable data for configuring an imaging device for printing is not indefinite. Ground No. 1 applies to the Section 112 rejection of Claims 1 and 39.

2. The recitation of a marking continuous from the face of the sheet to the edge is not indefinite. Ground No. 2 applies to the Section 112 rejection of Claims 1, 32 and 39.

3. The recitation of a fluid-based marking being imprinted on the edge and not imprinted on the face is not indefinite. Ground No. 3 applies to the Section 112 rejection of Claim 3.

4. The recitation of a sheet having or not having sufficient capillary action properties to carry the fluid-based marking onto the face from the edge is not indefinite. Ground No. 4 applies to the Section 112 rejection of Claims 3, 34 and 43.

5. Neither Brinkman patent teaches a marking representing machine readable data for configuring an imaging device for printing on the sheet or machine readable parameters corresponding to the sheet. Ground No. 5 applies to the Sections 102 and 103 rejections of all pending claims.

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6. The recitation of a marking representing machine readable data for configuring an imaging device for printing is not a recitation of intended use that the Examiner may ignore when determining patentability. Ground No. 6 applies to the Sections 102 and 103 rejections of Claims 1, 3-5 and 39-43.

7. Neither Brinkman patent teaches a marking imprinted on the edge of a sheet. Ground No. 7 applies to the Section 102 rejection of Claims 3 and 41-43.

8. Neither Brinkman patent teaches a sheet having sufficient capillary action properties to carry a fluid-based marking onto the face of the sheet from the edge of the sheet. Ground No. 8 applies to the Section 102 rejection of Claim 3.

9. Neither Brinkman patent teaches a stack of print media or a marking imprinted on the edge of a stack of print media and these limitations are patentably significant limitations that may not be ignored by the Examiner. Ground No. 9 applies to the Section 103 rejection of Claims 5 and 38.

10. Claim 39 is not a product-by-process claim. Ground No. 10 applies to the Section 103 rejection of Claim 39.

7. ARGUMENT.

GROUND NO. 1

**The recitation of a marking representing machine readable data for configuring an imaging device for printing is not indefinite.
(Claims 1 and 39)**

Claims 1 and 39 were rejected under Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 recites "a fluid-based marking ... representing machine readable data for configuring an imaging device for printing on the sheet." Claim 39 recites similar limitations.

In support of the rejection, the Examiner makes the following statements.

"Claims 1 and 39 recite 'the single fluid-based marking comprises data for configuring an imaging device', and 'the data is for configuring the image device to form images on the sheet', respectively, however, Applicant's specification on page 9, lines 17-19 recite the image forming device is configured to form images upon print media. Thus it is not clear how said marking comprises data for configuring an image device or how data configures an image device. Further, to say 'configure' is vague and confusing. How does fluid ink 'configure' a device, or image device? Does ink turn on

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the image device? How and what steps are involved to 'configure' a fluid-based marking to an image device?" Final Office Action, page 2.

According to the MPEP, the essential inquiry for this part of Section 112 is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed in light of the Specification, the teachings of the prior art, and the interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP 2173.02, citing *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Claim 1 recites a marking representing machine readable data. A typical bar code, for example, is one such marking. Bar codes, of course, are well known to everyone, including those having ordinary skill in the printer arts. Claim 1 recites that the data represented by the marking is for configuring an imaging device for printing on the sheet bearing the marking. The bar code shown in detail in Fig. 2, for a specific example, is a marking representing machine readable data such as the media parameters listed in the Specification at page 5, lines 15-24 (e.g., type of media, size, thickness, feed sped, fusing temperature, drying time). One example of the use of such media parameters to configure an imaging device is described in the Specification at page 14, line 14 through page 15, line 5. This teaching in the Specification is consistent with the fact that it is well known in the printer arts that printers and other image forming devices may be configured for various printing tasks, including printing on different types of media.

Appellant respectfully submits, therefore, that the language of Claims 1 and 39 when analyzed in light of the Specification sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity. It necessarily follows that unless and until the Examiner can show something in the teachings of the prior art or an interpretation by someone having ordinary skill in the pertinent art that negates Appellant's showing, the Section 112 rejection of Claims 1 and 39 should be withdrawn.

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GROUND NO. 2

**The recitation of a marking continuous from the face of the sheet to the edge is not indefinite.
(Claims 1, 32 and 39).**

Claims 1, 32 and 39 were rejected under Section 112, second paragraph, as being indefinite. The Examiner asserts that the recitation of a marking continuous from the face of a sheet to the edge of the sheet is "not clear" because "[t]he marking is imprinted, thereby making it incapable of being continuous. Print operations imprint discontinuous markings." Final Office Action, page 2.

The Examiner's statement is not correct. Modern printers are capable of printing continuous markings. Long lines, for example, can be printed with both laser and inkjet printers. The lines in a printed bar code, for another example, are continuous markings, each of which may be continuous from the face of a sheet to the edge of the sheet as shown in Fig. 2. If the Examiner is suggesting that the pixels that make up a printed marking are not, at a microscopic level, continuous, then she is respectfully requested to specifically so state and the Appellant will address the suggestion in a reply brief. If the Examiner is suggesting some other form of discontinuity, then a more detailed explanation is requested so the Appellant is not left to guess at the substance of the rejection.

GROUND NO. 3

**The recitation of a fluid-based marking being imprinted on the edge and not imprinted on the face is not indefinite.
(Claim 3)**

Claim 3 was rejected under Section 112 as being indefinite. In support of the rejection, the Examiner states that Claim 3 reciting the marking imprinted on the edge and not imprinted on the face appears to be contradictory to Claim 1 reciting the marking on the face and on the edge. Final Office Action, pages 2-3. The two claims are consistent. Claim 1 requires only that the marking be continuous from the face of the sheet to the edge of the sheet. Claim 3, which depends from Claim 1, requires a marking imprinted on the edge and not imprinted on the face. The marking, however, can still be on the face if, for example, the marking imprinted on the edge bleeds from

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the edge to the face, as shown in Fig. 3 and described in the accompanying text at page 6 of the Specification. Claim 3 also recites that the sheet has sufficient capillary action properties to carry the fluid-based marking onto the face from the edge.

Appellant respectfully submits, therefore, that the language of Claim 3 when analyzed in light of the Specification sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity. It necessarily follows that unless and until the Examiner can show something in the teachings of the prior art or an interpretation by someone having ordinary skill in the pertinent art that negates Appellant's showing, the Section 112 rejection of Claim 3 should be withdrawn.

GROUND NO. 4

**The recitation of a sheet having or not having sufficient capillary action properties to carry the fluid-based marking onto the face from the edge is not indefinite.
(Claims 3, 34 and 43)**

Claims 3, 34 and 43 were rejected under Section 112 as being indefinite. In support of the rejection, the Examiner makes the following statements.

"Claims 3, 34, and 43 recite 'the sheet has sufficient capillary action properties to carry the fluid-based marking onto the face from the edge', while claim 34 recites the sheet does not. It is not clear how this accomplished. Furthermore, according to the instant disclosure, description of Fig. 5 on page 8, lines 7+, the fluid based ink marking posses this characteristic and not the sheet (see also instant claim 34 claiming the sheet does not have sufficient capillary action). Additionally it is not clear how the fluid based marking is on the sheet by capillary action and imprinted on the edge and not the face." Final Office Action, page 3.

Claims 3 and 41 recite a sheet having sufficient capillary action properties to carry the fluid-based marking onto the face from the edge. As noted above for Ground No. 3, a marking imprinted only on the edge of such a sheet can bleed from the edge to the face, as shown in Fig. 3 and described in the accompanying text at page 6 of the Specification. In Claim 34, by contrast, the sheet does not have sufficient capillary action properties to carry the fluid-based marking onto the face portion from the edge portion. Hence, in Claim 34, unlike Claim 3, the marking is imprinted on both the face of the sheet and on the edge of the sheet. The claims are consistent.

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The Examiner's statement that "the fluid based ink marking possess this characteristic and not the sheet", referring to the description of Fig. 5 at page 8 of the Specification, is not understood. The Specification states at page 8, lines 12-15 that "if the print media do not have sufficient capillary action properties to carry the ink onto respective faces of the media, there will be no bleeding of the ink onto respective faces of 15 the print media." This statement is consistent with the language of Claims 3, 34 and 41 that the media, not the ink, has (or does not have) certain capillary action properties.

There is nothing indefinite about Claims 3, 34 or 43.

GROUND NO. 5

**Neither Brinkman patent teaches a marking representing machine readable data for configuring an imaging device for printing on the sheet or machine readable parameters corresponding to the sheet.
(All pending claims)**

All pending claims stand rejected under Section 102 as being anticipated by Brinkman (6090027) or Brinkman (6598783) (Claims 1, 3-4 and 41-43) or obvious over Brinkman '027 or Brinkman '783 (Claims 5, 32-34 and 38-39). The rejection of Claims 1, 3-4, 39 and 41-43 are all based on the assertion that both Brinkman patents teach a marking representing machine readable data for configuring an imaging device for printing on the sheet. Final Office Action, page 4. This assertion is not correct. (The Examiner does not address anywhere in the Action the recitation in Claims 32-34 and 38 of a marking representing machine readable media parameters corresponding to the sheet for Claims 32-34 or sheets in the stack for Claim 38.)

Claim 1 recites a fluid based marking representing machine readable data for configuring an imaging device for printing on the sheet. Claims 5 and 39 recite similar limitations. Neither Brinkman patent teaches these limitations. The various markings in Brinkman '027 represent machine readable data for the content, origin, destination or "other useful information about a parcel" or for pricing an item of merchandise. See, for example, Brinkman '027 column 4, lines 30-33 and 53-55; column 21, lines 7-10. Brinkman '783 does not expressly state the content of his machine readable parcel markings. It appears from the description of the parcels and the markings, however,

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that the markings represent data related to shipping a parcel and, perhaps related billing information. See, for example, Brinkman '783 column 3, lines 63-65.

The passages in each Brinkman cited by the Office as teaching this element of Claim 1 (Brinkman '027 Abstract and column 21, lines 10-20; Brinkman '783 Abstract and column 2, lines 22-35) clearly do not teach or even remotely suggest machine readable data for configuring an imaging device for printing on the sheet. The Examiner has been respectfully requested to specifically point out and explain those passages in either Brinkman patent that teach a marking representing machine readable data for configuring an imaging device for printing on the sheet, rather than simply quoting the claim element and then citing to a figure and passage in the reference that has no apparent relevance to the quoted claim element. In reply, the Examiner argues this limitation "is to intended use and is not germane to patentability." Final Office Action, page 9. The Examiner seems to concede, therefore, that Brinkman does not teach a marking representing machine readable data for configuring an imaging device for printing on the sheet.

The Examiner's "intended use" argument is addressed in Ground No. 6 below.

Claims 32 and 38 recite a marking representing machine readable media parameters corresponding to the sheet (Claim 32) or to the sheets in a stack of sheets (Claim 38). The Examiner has made no showing that either Brinkman patent teaches these limitations. In fact, they do not. As noted above, the various markings in Brinkman '027 represent machine readable data for the content, origin, destination or "other useful information about a parcel" or for pricing an item of merchandise. See, for example, Brinkman '027 column 4, lines 30-33 and 53-55; column 21, lines 7-10. Brinkman '783 does not expressly state the content of his machine readable parcel markings. It appears from the description of the parcels and the markings, however, that the markings represent data related to shipping a parcel and, perhaps related billing information. See, for example, Brinkman '783 column 3, lines 63-65. None of the Brinkman markings can in any way be considered to represent media parameters corresponding to the *sheet* on which they are printed.

The cited art does not teach or suggest a marking representing machine readable data for configuring an imaging device for printing on the sheet or machine readable parameters corresponding to the sheet as recited in each of the independent claims. The rejection of all pending claims should be reversed.

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GROUND NO. 6

**The recitation of a marking representing machine readable data for configuring an imaging device for printing is not a recitation of intended use that the Examiner may ignore when determining patentability.
(Claims 1, 3-5 and 39-43)**

Claim 1 recites a fluid based marking representing machine readable data for configuring an imaging device for printing on the sheet. Claims 5 and 39 recite similar limitations. The Examiner apparently does not give this limitation patentable weight because, the Examiner asserts, it "is to intended use and is not germane to patentability...." Final Office Action, page 9. This assertion is not correct.

While the disputed language may be deemed to have both structural and functional elements, it is not merely a recitation of intended use. The phrase "for configuring an imaging device" modifies "data." The marking represents this data. This is no less a structural limitation on the marking simply because it suggests the data will be used to configure an imaging device. To the extent "for configuring an imaging device" is deemed a functional limitation on the data, it is well settled that any such functional limitation is proper and must be accorded patentable weight. See e.g., *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430, 1433 (Fed. Cir. 1990); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) ("members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly).

The Examiner made this same argument, but in more detail, prior to the first appeal in this case. While the Examiner does not cite to any legal authority now to support her position, earlier she relied on *Ex parte Masham*, 2 USPQ.2d 1647 (BPAI 1987). Any such reliance on *Masham* is misplaced now just as it was during earlier prosecution, as noted in the Appellant's brief in the first appeal. In *Masham*, the Board held that the recitation of the material intended to be worked on by a claimed apparatus does not impose any structural limitations which differentiate it from a prior art apparatus satisfying the structural limitations of the claim. The Board then went on to state more broadly (and quite unnecessarily) that the "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus" Even this broad language in *Masham* has

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never been construed as a ban on functional limitations. Rather, the holding in Masham is limited to statements of intended use for "a claimed apparatus." Claim 1 is directed to a sheet of print media that includes a fluid-based marking -- an article of manufacture. The fluid-based marking representing data "for configuring an imaging device" is not a statement of intended use for "a claimed apparatus" or even the claimed article. Rather, it is a functional limitation that quite properly defines the data represented by marking.

GROUND NO. 7

Neither Brinkman patent teaches a marking imprinted on the edge of a sheet (Claims 3 and 41-43)

Claims 3, 41 and 42 depend from Claim 1 and recite the further limitation that the marking is imprinted on the edge of the sheet. Neither Brinkman patent teaches a marking imprinted on the edge of anything. Rather, in both Brinkman patents, the markings are imprinted on the face of a label, a box (while the box is flat/collapsed) or an envelope and then folder over.

The Examiner asserts without explanation that Brinkman '027 teaches a marking imprinted on the edge of a sheet at column 8, lines 37-40. Final Office Action, page 4. The cited passage in Brinkman '027 is quoted verbatim below.

"The label has a uniquely folded substrate which may be with or without indicia or ink.

The label is folded to attach it to a parcel on the parcel's corner. Also it can be applied as ink directly printed on a parcel substrate or as a molded corner"
Brinkman '027, column 8, lines 37-41.

The only language in this passage in Brinkman '027 that might be deemed even remotely relevant to the further limitation of Claims 3, 41 and 42 is the reference to "it can be applied as ink directly on a parcel substrate." Apparently, "it" refers to the label. It is not clear in Brinkman '027 how a "label", by definition, could be applied as ink directly on a parcel or what the parcel "substrate" refers to in this context, with apparent reference to Figs. 1a-1c. Nevertheless, it is clear that this passage does not teach a marking imprinted on the edge of a sheet. The markings on the labels in Figs. 1a-1c in Brinkman '027 are imprinted on the face of the label. Even if it assumed somehow that the ambiguous reference to applying ink directly on a

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parcel substrate means applying the marking directly on the parcel shown in Figs. 1b and 1c, any such application would not be on a sheet (unless of course the parcel is unfolded and laid flat in which case the marking would be imprinted on the face of the "sheet" and not on the edge).

The Examiner asserts without explanation that part number 41 in Fig. 6B of Brinkman '783 "and associated text" teaches a marking imprinted on the edge of a sheet. Final Office Action, page 5. Part number 41 in Fig. 6B designates a "barcode label." It seems clear from Fig. 6B, that the marking on label 41 is imprinted on the face of the label, not on the edge of the label. The fact that label 41 may be applied to the edge of a parcel is irrelevant because the marking is imprinted on the label, not on the parcel. And, the parcel is not a sheet in any event.

There is just no way either Brinkman patent can be construed as teaching a marking imprinted on the edge of a sheet.

GROUND NO. 8

**Neither Brinkman patent teaches a sheet having sufficient capillary action properties to carry the fluid-based marking onto the face of the sheet from the edge of the sheet.
(Claim 3)**

Claim 3 also recites a sheet having sufficient capillary action properties to carry the marking onto the face of the sheet from the edge of the sheet. The Examiner argues this limitation is taught by a Brinkman patent (which Brinkman patent is not specified) because "the same material is taught, therefore, it must inherently have the same properties, absent evidence to the contrary." Final Office Action, page 10.

First, the Examiner has an obligation to give some indication as to which passages or figures in the reference support the rejection. Having failed to do so, the rejection of Claim 3 should be reversed for this reason alone.

Second, "the same material" noted by the Examiner is, apparently, the material recited in Claim 3 — a sheet having sufficient capillary action properties to carry the marking onto the face of the sheet from the edge of the sheet. Neither Brinkman patent, however, teaches anything about the wicking/capillary action properties of any of the materials on which his markings are printed. Hence, it is seems non-sensical to say that one or both Brinkman patents teaches the same material of Claim 3. It would

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be helpful, therefore, if the Examiner could explain in more detail the basis for her assertion that one or both Brinkman patents teach a sheet having sufficient capillary action properties to carry the marking onto the face of the sheet from the edge of the sheet. Absent such an explanation, the rejection of Claim 3 should be withdrawn.

GROUND NO. 9

**Neither Brinkman patent teaches a stack of print media or a marking imprinted on the edge of a stack of print media and these limitations are patentably significant limitations that may not be ignored by the Examiner.
(Claims 5 and 38)**

Claim 5 recites a stack of print media sheets having a fluid-based marking imprinted on an edge side of the stack. Claim 38 recites a stack of print media sheets having a fluid-based marking imprinted on an edge side of the stack. The Examiner acknowledges that neither Brinkman teaches a stack of print media or a marking imprinted on the edge of a stack of print media. Final Office Action, pages 6 and 7. Instead, the Examiner asserts that:

"Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of faces, edge adjoining faces and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Final Office Action, pages 6-7 and pages 7-8.

It is not clear how these statements relate to the added limitations of Claims 5 and 38. If the Examiner is suggestion that a Brinkman patent could be modified somehow to arrive at the stack limitations in Claims 5 and 38 simply because neither patent teaches away from any such modification, the suggestion must be rejected.

Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must rely on objective evidence and make specific factual findings with respect to the motivation to modify references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Hence, the Examiner has an affirmative burden to produce evidence and make factual findings that it would

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have been obvious to modify a Brinkman patent to somehow reach the stack limitations of Claims 5 and 38. The Examiner cannot be deemed to have met this affirmative burden by the simple expedient of pointing out that the reference does not teach away from such a modification.

The fact is that neither Brinkman patent teaches or even suggests a stack of print media sheets or a marking imprinted on the edge of any kind of a stack.

GROUND NO. 10

Claim 39 is not a product-by-process claim. (Claim 39)

Claim 39 recites a stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed, and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet. Neither Brinkman patent teaches these limitations, and the Examiner makes no assertion to the contrary. Rather, the Examiner asserts that Claim 39 includes process limitations that must be ignored in determining patentability. In support of the rejection of Claim 39, the Examiner states:

"To claim 39, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. In re Bridgeford, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. In re Brown, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same." Final Office Action, page 7 and page 8.

The Examiner has not identified a single process limitation in Claim 39. In fact, there are none.

Claim 39 recites "each sheet in the stack being skewed ... with respect to the next sheet." Claim 39 does not recite any particular process through which the sheets came to be skewed. Claim 39 requires only that the sheets are skewed.

Claim 39 recites a "marking on the exposed face of each sheet and on an adjoining edge of each sheet" Claim 39 does not recite any particular process through which the marking came to be on the exposed face and on an edge of each

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sheet. Claim 39 requires only that there be a marking on the exposed face of each sheet and on an adjoining edge of each sheet.

The Examiner is respectfully requested to specifically point out and explain those limitations in Claim 39 she feels are process limitations. Absent such a showing, the rejection of Claim 39 should be withdrawn.

Respectfully submitted,

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APPENDIX I -- CLAIMS INVOLVED IN THE APPEAL

1. A sheet of print media, the sheet comprising:
 - a face;
 - an edge adjoining the face; and
 - a fluid-based marking on the face of the sheet and on the edge of the sheet, the marking continuous from the face of the sheet to the edge of the sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheet.
3. A sheet as recited in claim 1, wherein the sheet has sufficient capillary action properties to carry the fluid-based marking onto the face from the edge, the fluid-based marking being imprinted on the edge and not imprinted on the face.
4. A sheet as recited in claim 1, wherein the fluid-based marking is ink.
5. A stack of print media sheets having a fluid based marking imprinted on an edge side thereof, the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack.
32. A sheet of print media comprising:
 - a plurality of faces;
 - an edge adjoining each face; and
 - a fluid-based marking imprinted on a face of the sheet and on an edge of adjoining the face, the fluid-based marking continuous from the face of the sheet to the edge of the sheet and the marking representing machine readable media parameters corresponding to the sheet.
33. A sheet of print media as recited in claim 32, wherein the fluid-based marking is a barcode.

34. A sheet of print media as recited in claim 32, wherein the sheet does not have sufficient capillary action properties to carry the fluid-based marking onto the face portion from the edge portion.

38. A stack of print media sheets having a fluid based marking imprinted on an edge side thereof, the marking representing machine readable media parameters corresponding to the sheets in the stack.

39. A stack of print media sheets, each sheet in the stack being skewed at an angle with respect to the next sheet in the stack such that a portion of a face of each sheet is exposed, and a fluid-based marking on the exposed face of each sheet and on an adjoining edge of each sheet, the marking continuous from the face of each sheet to the edge of each sheet and the marking representing machine readable data for configuring an imaging device for printing on the sheets in the stack.

41. A sheet as recited in claim 1, wherein the fluid-based marking on the face of the sheet and on the edge of the sheet comprises a fluid-based marking imprinted on the edge of the sheet.

42. A sheet as recited in claim 1, wherein the fluid-based marking on the face of the sheet and on the edge of the sheet comprises a fluid-based marking imprinted on the edge of the sheet and on the face of the sheet.

43. A sheet as recited in claim 41, wherein the sheet has sufficient capillary action properties to carry the fluid-based marking onto the face from the edge.

APPENDIX II – EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

APPENDIX III – RELATED PROCEEDINGS

none